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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,244	05/17/2001	Maxon Duncan	604.12-US1	3875

34284 7590 12/01/2004

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/856,244	Applicant(s) DUNCAN ET AL.	
	Examiner Arrienne M. Lezak	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 6 & 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, Examiner finds the claim language "...is at least partially based on..." to be unclear, requiring alternate wording. For examination purposes, Examiner will assume that Applicant meant to include minimum "round trip time", (hereinafter "RTT"), as a factor in all gateway selection(s).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent US 6,654,373 to Maher in view of US Patent Pub. US 2002/0026360 A1 to McGregor.
5. Regarding Claims 1-3, 6 & 8, Maher discloses a client-server architecture teaching a method for load-balancing outgoing e-mail via e-mail source selection comprising:

- providing a network comprising an initiator and at least two alternative gateways distinct from the initiator, (per pending Claims 1, 2 & 8), wherein each gateway comprises a set of multimedia files for inclusion in generated messages and the set on any one gateway including the same files as the sets on all the other gateways, (per pending Claims 2 & 8), (Fig. 1 & Col. 4, lines 12-49), (Examiner notes that redundant load-balancers may obviously maintain many identical sets of files, which files include multimedia files, particularly in light of the fact that Maher teaches connection of the same to web servers.); and
- selecting a gateway from the at least two gateways, wherein attempts to minimize the time between when the gateway is requested to generate the message and when the recipient receives the message is a factor in the selection of the gateway, (per pending Claims 6 & 8), (Fig. 1 & Col. 4, lines 12-49), (Examiner notes that load-balancers within a network scenario are well-known in the art to be chosen based upon many factors, which factors obviously include minimal RTT.).

6. Maher does not specifically teach:

- a mail network;
- the initiator comprising a list of the multi-media files included in the sets on the gateways: comprising a database of message recipients which includes data on each recipient including the identified recipient: identifying a mail message recipient and using the data for the

identified recipient in identifying advertising material to be mailed to the recipient, (per pending Claims 1, 3 & 8);

- requesting the selected gateway to generate an e-mail message which includes the identified advertising material and to send the generated message to the recipient, (per pending Claim 8); and
- the selected gateway generating and sending the requested message, (per pending Claims 1 & 8).

7. McGregor discloses a mail network, (Title; Abstract; and paragraphs #0013-0016); the server (initiator) comprising a list of the multi-media files included in the sets on the gateways: comprising a database of message recipients which includes data on each recipient including the identified recipient: identifying a mail message recipient and using the data for the identified recipient in identifying advertising material to be mailed to the recipient, (per pending Claims 1, 3 & 8), (paragraphs #0031-0040, 0063-0064); requesting the selected gateway to generate an e-mail message which includes the identified advertising material and to send the generated message to the recipient, (per pending Claim 8); and the selected gateway generating and sending the requested message, (per pending Claims 1 & 8), (paragraphs #0031-0040, 0063-0064 & Claims 1-20).

8. To incorporate the McGregor email/advertisement attachment functionality into the Maher network would have been obvious to one of ordinary skill in the art at the time of invention by Applicant, as noted within McGregor which discloses that the two most widely used features of the Internet are the "web" and "e-mail", which together, enable

persons or entities to use the Internet for the purpose of selling goods and services to other users, (McGregor – paragraph #0004). As Maher discloses a webfarm consisting of web servers, (with both “web” and “e-mail” functionalities), connected to redundant load balancers and a database, it would have been obvious to use said webfarm for the common and well-known purpose of e-commerce, as noted within McGregor and Maher, (Maher – Col. 4, lines 58-60). Specifically, the use of the webfarm for e-mail distribution would be particularly optimal in light of the fact that the load-balancing capability would minimize the bottleneck effect common in networks. Moreover, in an alternate embodiment, Examiner finds that it would have been obvious to incorporate the database into the load-balancer within the Maher webfarm, further rendering Applicant’s claim to the same obvious. Thus, Claims 1-3, 6 & 8 are found to be unpatentable over the combined teachings of Maher in view of McGregor.

9. Regarding Claims 4 & 5, Maher alone and in view of McGregor discloses a method for load-balancing outgoing e-mail wherein the mail network is a WAN, (per pending Claim 4), and wherein the gateways are coupled to the INTERNET such that the generated message is sent to the recipient via the INTERNET, (per pending Claim 5), (Maher – Col. 4, lines 12-64). Thus, Claims 4 & 5 are found to be unpatentable over the combined teachings of Maher in view of McGregor.

10. Regarding Claim 7, Maher alone and in view of McGregor discloses a method for load-balancing outgoing e-mail wherein each gateway can determine the RTT between itself and the recipient's machine and the determined RTT is a factor in gateway selection, (Maher - Fig. 1 & Col. 4, lines 12-49). Examiner notes that load-balancers

within a network scenario are well known in the art to be chosen based upon many factors, which factors obviously include minimal RTT. Moreover, Examiner notes that Maher does disclose the distinction between slow-path and fast-path packet processing, (Maher – Col. 1, lines 60-67 & Col. 2, lines 1-13). Thus, Claim 7 is found to be unpatentable over the combined teachings of Maher in view of McGregor.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner

William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.

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